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Supreme Court of the United States.

OCTOBER TERM, 1948.

No. 343

UNITED SHOE MACHINERY CORPORATION,
Petitioner,

v.

JACOB S. KAMBORIAN
AND
INTERNATIONAL SHOE MACHINE CORPORATION,
Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIRST CIRCUIT

AND

BRIEF IN SUPPORT THEREOF.

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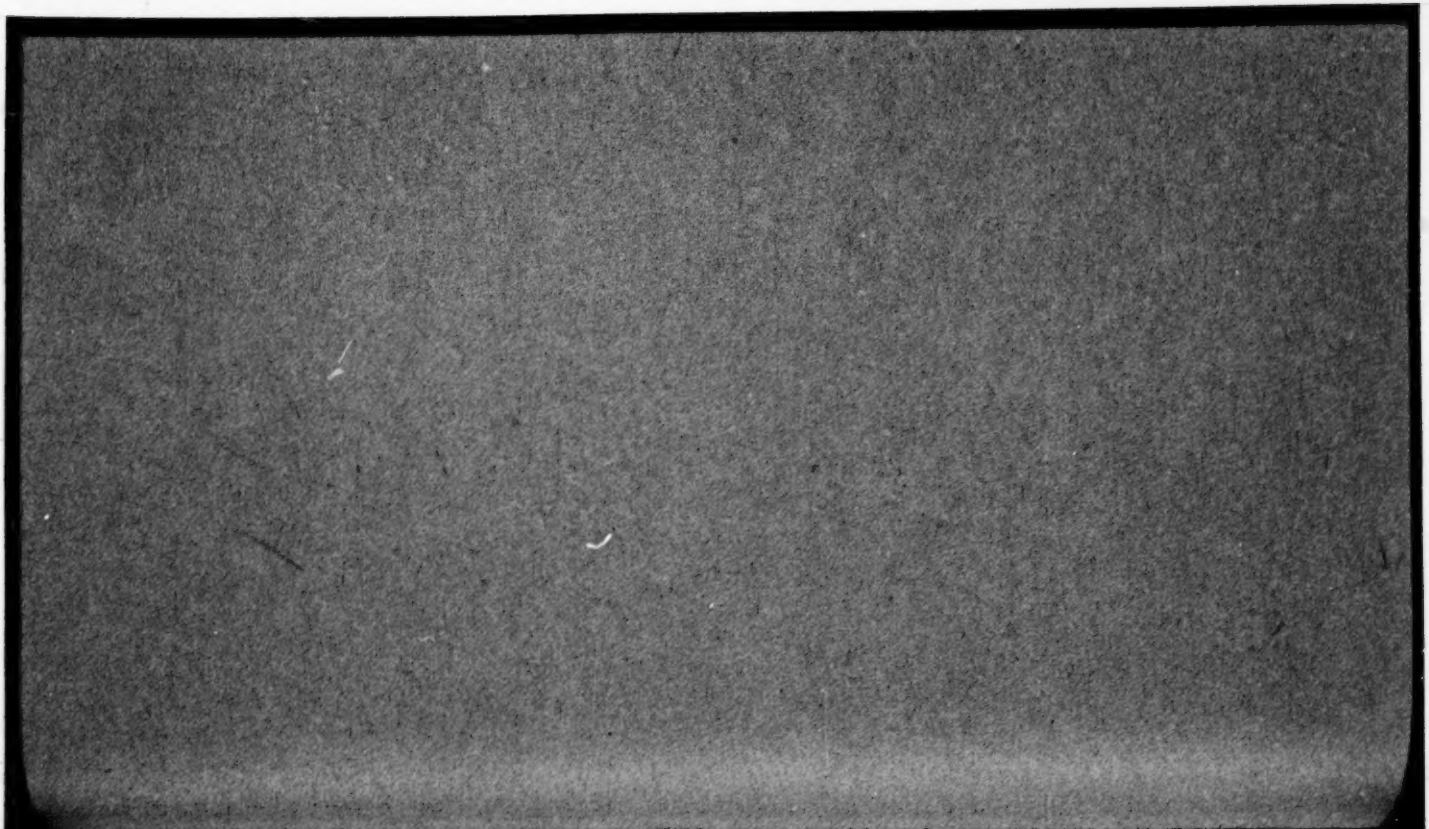

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To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, United Shoe Machinery Corporation, respectfully prays for a writ of certiorari to the United States Court of Appeals for the First Circuit, to review a judgment of that Court entered on or about July 16, 1948, said judgment affirming a judgment of the District Court entered on remand following a previous appeal.

The opinion of the Circuit Court of Appeals on the present appeal appears at RII, 107.* The opinion of the

*We refer herein to the Transcript of the Record on the first appeal as RI, and to the additional Transcript of the Record on the second appeal as RII.

District Court on remand appears at RII, 17, and is reported at 73 Fed. Supp. 548. The opinion of the Circuit Court of Appeals on the first appeal appears at RII, 21, and is reported at 160 Fed. (2d) 461. The original opinion of the District Court appears at RI, 11, and is reported at 62 Fed. Supp. 903.

The jurisdiction of this Court to review said judgment is conferred by Section 1254 of Title 28 of the United States Code.

Summary and Short Statement of the Matters Involved.

Petitioner was defendant below in a suit for infringement of Kamborian Patents Nos. 2,251,284 and 2,254,224 (RI, 27, 183-204), the first being for a machine and the second for a method supposed to be performed by the machine. Except for the claims, the two patents are practically identical, being the result of dividing a single original patent application. Only four of the fifty-five claims of the patents are in suit, being Nos. 26 and 28 of the machine patent No. 2,251,284 and Nos. 13 and 19 of the method patent No. 2,254,224.

THE PATENTS IN SUIT.

The claims in suit are very broad and those pertaining to the machine define the alleged invention in terms of "means" qualified by a statement of the function which the said means are intended to perform. The machine claims 26 and 28 read as follows:

> "26. Shoe lasting apparatus comprising upper stretching means and in-wiping means, the stretching means being designed and arranged positively to grip a narrow area of the margin of the upper and, after stressing the gripped portion of the margin in a direc-

tion substantially perpendicular to the last bottom, to release the gripped area while concomitantly gripping an adjacent area, the wiping means being constructed and arranged to wipe in each area of the margin only after such area has escaped from the stressing means."

"28. Shoe lasting apparatus comprising upper gripping means operative to seize a narrow area of the margin of the upper and positively to stress such margin in a direction substantially perpendicular to the bottom of the last thereby to stretch it snugly about the last, means operative to wipe in a narrow area of the marginal material which has already been stressed and released by the gripping means and closely adjacent to but spaced from a point at which said stress is being concomitantly applied, and means operative to cause relative movement of said stressing and wiping means and the last whereby the points of stressing and wiping progress along the edge of the insole."

The patents in suit describe and illustrate a simple shoe lasting machine comprising stretching means to stretch the shoe upper tightly about a wooden last and in-wiping means to fold the lasting margin of the stretched upper over into facing engagement with an insole on the last, the lasting margin being secured to the insole by suitable fastening means, shown in the patents as adhesive or metallic fasteners. The only stretching means described in the patents is a pair of oppositely rotating rolls, vertically disposed, between which the lasting margin of a shoe upper is securely gripped and fed by rotation of the rolls to the in-wiping means. The in-wiping means disclosed is a conventional reciprocating blade. The de-

scribed machine also includes devices for positioning the shoe laterally and for maintaining the shoe bottom in a horizontal plane normal to the axes of the rolls.

It is old *per se* to employ angularly disposed rolls to feed and tension leather in the making of shoes and very old to employ reciprocating wiper blades in the lasting of shoes. Stretching means and wiping means are, of course, the essential elements of most lasting machines.

However, the rolls of the patents in suit are not angularly disposed, or inclined, to obtain a component of up-pull as the shoe is fed, but the vertical rolls are formed like screws with upwardly spiralling ribs in the roll surfaces. The patents teach that as the rolls rotate "they exert a strong upward stress, by reason of their helical ribs, tending to stretch the upper about the last" (RI, 189, col. 2, ll. 15-17, and RI, 201, col. 2, ll. 18-20). The patents also teach, as indeed the claims require, that these stretching means are operable to stress the gripped portion of the margin in a direction substantially perpendicular to the last bottom, "thereby to stretch it snugly about the last," and that the wiper operates "only after such area has escaped from the stressing means" to wipe in a narrow area of the marginal material "which has already been stressed and released" (Cls. 26 and 28, *supra*, pp. 2, 3).

Not only are the gripper rolls the sole means disclosed in the patents for stressing or tensioning the upper, but also all the claims in suit of both patents are distinctly limited to a machine and method in which the tensioning is produced only before and independently of the wiper.

Thus claim 26 of patent No. 2,251,284 calls for "the wiping means being constructed and arranged to wipe in each area of the margin *only after such area has escaped from the stressing means*"* (gripper rolls) (*supra*, pp. 2, 3).

*Emphasis ours throughout.

Claim 28 of the same patent requires "means operative to wipe in a narrow area of the marginal material *which has already been stressed and released by the gripping means*" (*supra*, p. 3).

Claim 13 of patent No. 2,254,224 provides the steps of "*seizing* a narrow area of the margin of the upper and *applying positive lasting pull thereto,*" and feeding, preliminary to wiping (RI, 203).

Claim 19 of patent No. 2,254,224 calls for "wiping in such portions of the margin *as they are released from the gripping means*" (RI, 203).

These limitations were the price of allowance of the claims. Thus, in the amendment to the application for patent No. 2,251,284, in which claims 26 and 28 were amended by adding the italicized portions of the above-quoted limitations, Kamborian's attorney said (RI, 252):

> "As contrasted with this [prior art] *in applicant's machine, the wiper only engages that part of the upper material which has previously been gripped, stretched and released by the gripping means* (see page 11 of the specification, beginning at line 15)."

Now, it is a fact, recognized by the District Court and accepted by the Court of Appeals, that Kamborian's helically ribbed rolls will not stretch the upper "snugly about the last," as the patents teach and claim, before releasing the stock for engagement by the wiper. Instead, the Courts have found that, although the rolls provide "some" stretch, it is the old wiper, operating in combination with the rolls, that provides the stretch sufficient to do the necessary continuous lasting claimed (RII, 21, 108). Since lasting in this manner is not disclosed in the Kamborian patents, it is submitted that, as a matter of law, the claims in suit ought to have been declared invalid as failing to

comply with the provisions of R.S. Sec. 4888,* which require, as a condition of the patent grant, "in the case of a machine," that the applicant "shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions."

This is not the familiar case of a patentee harmlessly setting forth an erroneous theory of the reasons for the operation of a machine claimed in terms of structure or mechanism. It is a case where, by the use of functional language, the patentee has claimed only an erroneous principle of machine operation and no structure or mechanism whatever.

Petitioner has steadfastly contended and believes that it has proved by a great preponderance of the evidence, contrary to findings of the Courts below, that no lasting, stretching, stressing or tensioning whatsoever can be obtained by the helical ribs of Kamborian's rolls any more than a fly alighting on the surface of a barber pole would be elevated in the course of its ride about the pole's axis.

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*SEC. 4888. (U.S.C., title 35, sec. 33.) "Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

All points on the surfaces of the rolls and their ribs necessarily move about the vertical axes of the rolls in horizontal planes. Hence, lifting of the positively gripped shoe stock by the spiral ribs is impossible, and any apparent rise is pure optical illusion. However, a review by this Court of the erroneous findings of the lower Courts on these points, while warranted, is not essential, since the errors of law herein relied upon arise from the facts as found by the lower Courts.

The Accused Machine.

The accused machine consists of a single rotating roll, lacking the helical ribs of the Kamborian rolls, and disposed at an angle to the shoe bottom rather than normal thereto as in the Kamborian patents. The lasting margin of a shoe is spring pressed against the roll by a smooth polished sleeve. The single, unribbed roll thus feeds the stock at an angle upwardly and forwardly, thereby stressing the stock before it is engaged by a chain wiper operating to lay the stressed margin on the shoe bottom, where it is secured by adhesive. Certain novel features of petitioner's accused machine were patented since this suit commenced but on an earlier filed application which resulted in U.S. Patent No. 2,397,369, owned by petitioner. The patented features relate to arrangements which include overdrawing the upper stock after tensioning and before wiping.

The Decisions Below.

The First Decision of the District Court:

The Court held the patents valid and the claims in suit infringed. On the issue of the operability of the helically ribbed rolls to tension, the Court said:

"Kamborian, the patentee, is a man of considerable mechanical ability but his knowledge of mechanical principles and theories has not been demonstrated. At the time that he filed his patent application he was of the opinion—and probably is today—that the introduction of material between such rolls as he describes in his invention would have a tendency to uplift or pull it. . . . Undoubtedly, while there is direct engagement of the cloth between the ribs there may be some such upward pull, but the pull, if any, on the material is not sufficient to completely tension the material to conform to the contour of the wooden last. Such additional tension as may be needed is provided by the operator who exerts pressure by pushing the last inwardly towards the body of the machine, or by presenting the work at an angle to the rotating gripping rolls. The resulting tension is sufficient to do a workmanlike job in conformance with the patent claims. Whether or not Kamborian understood all that his machine would do at the time that he described it in his patent application is immaterial. He is entitled to the benefits of all that he has created. With a few minor improvements, the machines that Kamborian has built read directly on the patents" (RI, 13).*

And the Court remarked that "it is immaterial that the principle of operation is not as described in the patent, . . ." (RI, 14).

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*Significantly, Kamborian has discarded the vertical rolls with helical ribs and has substituted unribbed rolls which are inclined like defendant's roll (RII, 67). The "few minor improvements" referred to by the Court are subject-matter of a subsequent patent to Kamborian, No. 2,251,285, not in suit (RI, pp. 90, 439 and 459).

The First Decision of the Court of Appeals:

The Court of Appeals affirmed the finding of infringement but vacated the judgment and remanded the case to the District Court for further proceedings on the question of validity, saying:

> "While the shoe is in this position these rolls with the helical ribs are supposed to pull up the material and the wiper to smooth it down" (RII, 24).
>
> "It is quite clear in reading the inventor's application as a whole what he had in mind. He had a perfectly integrated theory about combining these various operations into one in his machine. Its fundamental premise was the supposed upward pull of his helical ribs" (RII, 26).
>
> ". . . It is undoubtedly the law that a man is entitled to the benefits of his invention whether his theory in explaining how he got his result is right or not. Thus if he describes a certain process and explains that the result is due to a given chemical change he is entitled to the benefit of the process even though the explanation of the result may be incorrectly stated. But Kamborian's situation is quite different as the statute requires that he describe his machine and tell how to work it. If it does not work as described, that it works some other way is not enough.
>
> "We think that the controlling question is whether Kamborian's helical ribs do what he said they do. We disagree with the learned District Court's statement that if they do not Kamborian even then has produced a machine which conforms to his patent" (RII, 27, 28).

The Second Decision of the District Court:

The District Court, after permitting further trial and demonstration on petition of the plaintiff, again held the claims valid and infringed. The Court stated (RII, 18) that it "completely abandoned" its earlier finding respecting the operation of the helically ribbed rolls and found in answer to questions propounded by the Court of Appeals that, although the helical ribs do provide "some" upward pull, sufficient pull to do the necessary continuous lasting claimed was "provided by the combination of the helical ribs and the wiper" (RII, 20, 21). It will be noted that by this new finding the Court failed to abandon its earlier view that something other than the helical ribs is essential to obtaining lasting tension. In the first opinion it was the operator contributing lasting force, and in the second opinion it was the wiper which was found necessary to perform the stretching function claimed for the helical ribs.

Second Decision of the Court of Appeals:

On the second appeal to the Court of Appeals petitioner contended that, since the District Court had now found the action of the wiper to be an essential part of the "stretching means" of the patents, the claims were void because the patents state unequivocally in their specifications and claims that the stretching is performed by the gripper rolls alone, independently of the wiper. Petitioner further contended that, if the claims in suit were construed as directed to a combination of gripper means and wiper to effect tensioning, petitioner's machine did not infringe, because it operated on the different principle of tensioning by the gripping means alone.

The Court of Appeals, accepting the District Court's findings under Rule 52, overruled petitioner's said conten-

tions and affirmed the judgment of the District Court. The Court, observing that "Kamborian is bound to show how his machine works but not why," held that his burden in that regard was "satisfied" by tests conducted by respondent in the District Court upon which that Court based its finding that the machine of the patents produced lasting tension by combined action of the gripper rolls and wiper.

The Court did not purport to find any disclosure in the patent that the wiper plays any part in tensioning, which would be contrary to fact and to the Court's previous findings that the patent discloses only tensioning by the helically ribbed gripper rolls alone. Instead, the Court merely said that the patents in suit disclose a machine in which the wiper could be made to produce sufficient tensioning in combination with the gripper rolls by adjustments within the realm of mechanical skill.

The second decision of the Court of Appeals, therefore, is in direct conflict with its first decision, wherein the Court said: "If it does not work as described, that it works some other way is not enough" (*supra*, p. 9).

In a footnote to the opinion the Court dismissed petitioner's contention of non-infringement, stating that "The change of finding on what supplies the additional tensioning in the plaintiff's machine . . . is of no legal significance" (RII, 109).

Effects of the Enlargement of the Patents.

If the decision of the Court of Appeals is permitted to stand, it is clear that the scope of the Kamborian patents has been greatly enlarged by this judicial interpretation of their claims. Instead of a machine having two operating instrumentalities working independently, and in sequence, to last the shoe, first stressing means and then wiping means, as the language of the claims clearly de-

fines, the patents must now be understood to embrace a machine in which both means work *in combination* to obtain the stressing function.

More seriously, in view of the holding of infringement by petitioner's single unribbed roll and chain wiper machine, the claims might now be interpreted as infringed by all conceivable combinations of structures capable of performing the described lasting and wiping functions, whether such structures operated in sequence or in combination with each other, and whether now known or still in the realm of future invention.

In petitioner's machine it is the inclined roll alone that obtains the lasting tension, and respondents relied heavily on this fact in establishing infringement at the trial. If, as the Court of Appeals has found, Kamborian's real invention was the tensioning by a combination of the rolls and wiper, then petitioner has been unjustly convicted of infringement.

Questions Presented.

1. Are patent claims valid despite the fact that the patents explain an erroneous principle of a machine and the claims define only said erroneous machine principle?

2. Where patent claims define mechanism only as means qualified by a statement of the function which the said means are intended to perform, are the claims valid when it is found that the only mechanism described by the patentee for performing the function is in fact incapable of performing it?

3. Where the language is clear and unmistakable, and there is no ambiguity to be resolved, may the meaning of patent claims be changed by judicial interpretation to save their validity, even though such change nullifies amend-

ments which were essential to the allowance of the claims by the Patent Office?

4. Where patent claims are prima facie infringed, does infringement in fact exist when, to save their validity, the claims are judicially construed as defining a machine principle different from the principle of the accused machine? Must not the claims receive the same interpretation for the purpose of finding infringement as for finding validity?

Reasons Relied upon for the Allowance of the Writ.

Petitioner believes that writ of certiorari should be granted in this case for the following reasons, and accordingly the discretionary power of this Court is invoked:

1. The Circuit Court of Appeals has decided the following important questions of Federal law which have not been, but should be, settled by this Court:

a. That claims of a patent are valid despite the fact that the patent sets forth an erroneous explanation of the principle of a machine and said claims define only said erroneous machine principle. (R.S. Sec. 4888 requires that in the case of a machine the patent "shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions.") (*Supra*, p. 6.)

b. That claims of a patent are valid despite the fact that the claims define means for performing a function which the disclosed means is incapable of performing.

c. That, although the language of a patent is clear and unmistakable, and there is no ambiguity to be resolved, the meaning of the patent claims may be changed by judicial interpretation to save their valid-

ity, even though such change nullifies amendments which were essential to the allowance of the claims by the Patent Office.

d. That patent claims may be construed as defining one machine principle for the purpose of saving their validity, and as defining a different machine principle for the purpose of establishing their infringement.

2. The Circuit Court of Appeals has decided each of the following Federal questions in a way probably in conflict with applicable decisions of this Court:

a. That a patent can be interpreted as disclosing and claiming a combination of two means co-acting to perform a designated function and nevertheless be held infringed by a machine in which said function is performed by a single means.

Westinghouse v. *Boyden Power Brake Co.*, 170 U.S. 537.

b. That claims of a patent which recite only "means" qualified by statements of function are not invalid for failure to comply with the provisions of R.S. Sec. 4888.

United Carbon Co. v. *Binney & Smith Co.*, 317 U.S. 228.

Halliburton Oil Well Cementing Co. v. *Walker*, 329 U.S. 1.

3. Further litigation which could result in a conflict of opinion between the Courts of Appeals of different circuits is unlikely as the shoe machinery industry here affected is concentrated in the First Circuit.

Schriber-Schroth Co. v. *Cleveland Trust Co.*, 305 U.S. 47, 50.

MacKay Radio & Telegraph Co. Inc. v. *Radio Corporation of America*, 306 U.S. 86, 89.
Exhibit Supply Co. v. *Ace Patents Corp.*, 315 U.S. 126, 128.
Muncie Gear Works, Inc., v. *Outboard, Marine & Manufacturing Co.*, 315 U.S. 759, 766.

4. The Circuit Court of Appeals has rendered two conflicting decisions in this case respecting the proper application of a Federal law (R.S. Sec. 4888). Although these separate conflicting decisions were rendered by the same Court, they were rendered at different times and the personnel of the Court was not identical on both occasions. It is therefore submitted that the spirit, if not the letter, of the Supreme Court Rule 38, Sec. 5, Par. *b*, is applicable.

Respectfully submitted,

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

I.

The Decisions Below Sustain Claims Defining Only an Erroneous Machine Principle.

The question whether patent claims which define only an erroneous explanation of the principle of a machine may be sustained as valid is an important one which apparently has never engaged the attention of this Court. The statute (R.S. Sec. 4888)* requires that in the case of a machine the principle thereof shall be explained. The question arises in this case because—

a. The findings of the Courts below conclusively establish that the patentee has erroneously described how his machine operates and he has based his claims entirely on his erroneous theory; and

b. The Courts below have sustained the claims in suit as valid on fact findings to the effect that, with certain minor changes within the capacity of a skilled mechanic, the machine of the patents may be made to operate in accordance with a different machine principle not described, explained or even contemplated by the patentee.

The patents in suit describe the operation of the machine as based upon tensioning by the helically ribbed gripper rolls and subsequent, independent wiping action by the wiper. The patents say, "as the gripper rolls 36 and 37 rotate, they exert a strong upward stress, by reason of their helical ribs, tending to stretch the upper about the last" (*supra*, p. 4). The Court of Appeals found in its first opinion: "In Kamborian's words, 'the marginal ma-

*Quoted at page 6, *supra*.

terial of the forepart and sides is first drawn upwardly in a direction substantially perpendicular to the bottom of the insoles and then . . . is wiped in over the edge of the insole into smooth contact with the latter; . . .' *The perpendicular stress is supposed to come from two gripper rolls*" (RII, 22). And again: "While the shoe is in this position these rolls with the helical ribs are supposed to pull up the material and the wiper to smooth it down" (RII, 24).

In their second opinions both the District Court and the Circuit Court of Appeals have found that the gripper rolls, the "tensioning means" of the patents, will not of themselves supply the requisite lasting tension as the patentee thought, but instead that his machine requires, in order to last a shoe, tensioning by conjoint simultaneous action of the gripper rolls and the wiper. The District Court found that "the pull provided by the *combination* of the helical ribs *and the wiper* . . . is sufficient to do the necessary continuous lasting claimed by the invention" (RII, 21), and the Court of Appeals approved this finding, saying that "these opposite forces [gripper rolls and wiper] must necessarily result in a stretching of the material therein engaged" (RII, 111).

These findings conclusively establish that Kamborian has erroneously described how his machine operates.

In its second opinion, the Court of Appeals did not purport to find any disclosure in the Kamborian patents that the wiper aids in producing tension. The Court merely said "the wiper is intended to be in such a position that it engages the leather before all of it has cleared the gripper rolls," and that in such case tensioning by conjoint action of the gripper rolls and the wiper "must necessarily result" (RII, 111).

The erroneous principle of operation of the Kamborian machine described in the patents was carried into the

claims in suit by amendments made to distinguish from the prior art (*supra*, p. 5).

In upholding Kamborian's claims in suit, the Court of Appeals adverts to two decisions of this Court—*Eames* v. *Andrews*, 122 U.S. 40, and *Diamond Rubber Co. of New York* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428. These cases are referred to as supporting the proposition, cited by the Court of Appeals, that "The physical or mechanical law which makes this machine operate in a certain way is interesting but is immaterial patentwise" (RII, 110).

This proposition is supported by the cases cited; but neither the proposition nor the cases cited in support of it are decisive of the issue of the validity of the claims in suit under R.S. Sec. 4888 (*supra*, p. 6). It may be true, as stated in the Diamond Rubber case (*supra*), that it is not necessary for the inventor to "understand or be able to state the scientific principles underlying his invention," but this is not to say that the statute does not require the inventor to describe accurately *how* his machine operates. It merely says that it is immaterial whether or not he explains accurately *why* it so operates.

In other words, Kamborian is not in the position of a patentee who has correctly described how his machine operates, but has set forth an incorrect theory of the physical or mechanical laws which make it operate in the way it is described. On the contrary, on the findings in the lower Courts, the patentee has erroneously described how his machine works and has claimed it in terms of that erroneous explanation. This Court has recently had occasion to condemn claims drawn broadly in terms of means and their functions. *Halliburton Oil Well Cementing Company* v. *Walker*, 329 U.S. 1. Here, not only are the claims drawn in such terms, but the functions set forth are erroneous.

In *Beidler* v. *United States*, 253 U.S. 447, 453, this Court found the claims invalid as failing to define a "useful"

invention within the meaning of R.S. Sec. 4886. However, this Court there referred at length to the requirements of R.S. Sec. 4888, and said:

> "Ever since *Grant* v. *Raymond,* 6 Pet. 218, 247, it has been consistently held that a correct and adequate description or disclosure of a claimed discovery (which, in the case of a machine, involves particularly the operation of it) is essential to the validity of a patent."

Thus this Court has clearly stated that the statute requires the patentee to describe correctly the operation of his machine. This Kamborian has not done.

Although the Court of Appeals, in its second decision in the case, recognized that under the statute "Kamborian is bound to show how his machine works," the Court held his burden in that respect satisfied because it found that the directions given in his patent for operating his machine were sufficient (RII, 109). The Court thus interpreted the statute as requiring only that Kamborian describe how to operate his machine, not how the machine operates.

Petitioner submits that R.S. Sec. 4888, will not bear this interpretation. It requires not only that the principle of a machine shall be explained, but also that, as to any invention, including a machine, the application shall set forth the "process of making, constructing, compounding, *and using it.*" Thus the "principle" of the machine, which the statute says must be explained, is necessarily something different from the manner of using the machine, which the statute also says must be explained, and must be, as stated by this Court in the Beidler case, the manner in which the machine operates.

II.

The Courts Below have Eliminated from the Claims, by Interpretation, Express Limitations to an Erroneous Principle of Operation.

Kamborian's erroneous theory that his gripper rolls alone would provide the requisite lasting tension was carried into his claims in suit by amendments which state that the wiper acts only after the "stressing means" (gripper rolls) have applied the lasting tension, thereby expressly excluding the wiper as any part of the tensioning means (*supra*, p. 5). These limitations were the price of allowance of the claims, Kamborian's attorney asserting that the prior art was thereby distinguished because "the wiper only engages that part of the upper material which has previously been gripped, stressed and released by the gripping means" (*supra*, p. 5).

The lower Courts have found, as previously pointed out (*supra*, pp. 5, 17), that the requisite lasting tension in Kamborian's machine is only obtained by conjoint action of the gripper rolls and the wiper. Thus, upon the findings of the Courts below, Kamborian obtained his claims in suit for an invention which he did not make.

Nevertheless, the Courts below have, in effect, eliminated these limitations of the claims by interpreting the claims as if they were drawn to a combination of gripping means and wiper to obtain tension, which the Courts have found to be the actual principle upon which the Kamborian machine can be made to operate.

This Court has indicated that "in a proper case a claim may be upheld by reference to the descriptive part of the specification in order to give definite content to elements stated in the claim in broad or functional terms" *General Electric Co.* v. *Wabash Appliance Corp.*, 304 U.S. 364, 373. Obviously, this is not such a case, not only because the

terminology of the claims is plain and requires no interpretation, but also because the specifications of Kamborian's patents completely failed to indicate that the wiper has any part in tensioning and instead said plainly that the tensioning is accomplished only by the gripper rolls.

On the other hand, this Court has held that "limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers." *Smith* v. *Magic City Kennel Club, Inc.*, 282 U.S. 784, 790. This rule appears to have been applied by this Court heretofore only in cases in which the patentee was seeking to broaden his claim to include as an infringement a device which was excluded by the amendment. Petitioner submits, however, that the rule was intended to be of broader application and to forbid any interpretation of claims which eliminates express limitations added to the claims as the price of allowance, whether for the purpose of sustaining the claims or of holding them infringed.

Petitioner further submits that, once an applicant has restricted his claims by amendment to a given principle of operation, a Court may not interpret those claims as defining an invention involving a different principle of operation and that this is an important question of patent law which should be settled by this Court.

III.

The Interpretation of the Claims on Which the Court Found Them Valid Excludes the Machine Alleged to Infringe.

If Kamborian's machine claims had accurately described his invention as involving a combination of wiper and gripper means to obtain tensioning, petitioner's machine would clearly not have infringed. For it was shown by

respondents' own proofs that in petitioner's machine the tensioning is accomplished by the inclined gripper roll alone and not by its co-action with the wiper (RI, 80, 81).

Petitioner's machine, therefore, would not infringe claims drawn to a combination of gripper means and wiper to effect tensioning, both because petitioner's machine operates upon a different principle and because one element of such claimed combination would be missing in petitioner's machine. *Westinghouse* v. *Boyden Power Brake Co.*, 170 U.S. 537.

The Court of Appeals has sustained Kamborian's claims by interpreting them as if they called for tensioning by a combination of gripping means and wiper, although they are expressly limited to a machine in which tensioning is accomplished by means independent of the wiper. Yet the Court also holds the claims infringed by a machine in which the tensioning is accomplished independently of the wiper. Thus, by failing in his claims to describe accurately the invention, Kamborian is permitted to cover not only the invention which it is found he did make but also an invention which it is found he did not make.

In *Halliburton Oil Well Cementing Co.* v. *Walker*, 329 U.S. 1, this Court said (at page 13):

> "Certainly, if we are to be consistent with Rev. Stat. 4888, a patentee cannot obtain greater coverage by failing to describe his invention than by describing it as the statute commands."

In holding Kamborian's claims both valid and infringed the Court of Appeals has allowed Kamborian to do exactly what this Court so condemned in the Halliburton case.

Petitioner submits that the holdings of the Courts below as to infringement conflict with the decisions of this

Court as set forth above and should be reviewed and reversed by this Court.

IV.

Public Importance of Questions Raised.

The questions of patent law adjudicated by the Courts below and made the basis of this petition are of far reaching consequence and unusual public importance, vitally affecting all patents based on machines or their operation, probably the most numerous of all types.

According to the decisions of the Courts below, a patent satisfies the requirements of R.S. Sec. 4888, if it describes a machine and gives directions by which the machine can be made to work, *i.e.*, "tells how to work it," as the Court of Appeals said in its first opinion. It matters not that a patent fails to explain the manner in which the machine operates or, as in the instant case, does so erroneously and claims the invention only in terms of the erroneous explanation.

The decisions thus render nugatory the requirement of the statute that in the case of a machine the patent "shall explain the principle thereof . . . so as to distinguish it from other inventions." For the statute provides in addition that the "manner and process of . . . using" a machine shall be explained, which is all that the Courts below have held is meant by the requirement that the *principle* of the machine shall be explained.

It is believed that this interpretation of R.S. Sec. 4888, is not in accordance with the intention of Congress expressed in the statute, and changes the law as it had theretofore been understood. Certainly, the question herein raised of the propriety of this interpretation, which has not heretofore been decided by this Court, is of vital consequence to all owners of, and applicants for, patents based

on machines or their operation and to all who manufacture, deal in or use machines.

The immediate public interest in the requirements of R.S. Sec. 4888, is evidenced by the proposals recently made by the Milwaukee Patent Law Association and which were under consideration by the American Bar Association at its 1948 annual meeting (Reported in the American Bar Association Committee Reports, Annual Meeting, September 5-7, 1948, Section of Patent, Trade Mark and Copyright Law). As proposed by the Milwaukee Association, the statute would be amended to omit any requirement that the principle of a machine shall be explained, on the ground that it adds nothing to the other requirements of the statute (*ibid.*, p. 27). The American Bar Association Committee having the proposals under consideration was in disagreement with the Milwaukee Association (*ibid.*, pp. 27-28). This is believed to indicate clearly that, whatever import this provision of the statute may have, the Patent Bar is in doubt as to its significance. There appears to be no decision or utterance of this Court that clearly establishes the meaning of the requirement of the statute that a machine *principle* shall be explained, and it is submitted that in the absence of guidance from this Court the Patent Bar is unable safely to advise and to assist in the proper preparation of patent applications for machines and in the interpretation of machine patents.

Likewise of vital importance to all who are concerned with machines and patents therefor are the questions herein raised of the propriety of the extraordinary liberties of interpretation in which the Courts below have indulged in order to hold valid and infringed means-function claims in which the function is wrongly stated, particularly in view of this Court's apparently contrary admonitions in the Halliburton case.

V.

Conclusion.

We respectfully submit that this petition presents questions of law of the utmost importance, affecting the scope of the patent laws and patent rights, which have not been, but should be, settled by this Court, or which are contrary to previous decisions of this Court; that the interpretation which the Courts below have placed on R.S. Sec. 4888 is not in accordance with the intention of Congress as expressed in that statute, nor in the best interest of the public; and that the writ should be granted in order that this Court may authoritatively pass upon these questions.

Respectfully submitted,

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Supreme Court of the United States.

OCTOBER TERM, 1948.

No. 343.

UNITED SHOE MACHINERY CORPORATION,
Petitioner,
v.
JACOB SIMON KAMBORIAN
AND
INTERNATIONAL SHOE MACHINE CORPORATION,
Respondents.

REPLY BRIEF FOR PETITIONER.

Respondents' brief (pp. 9, 11) accuses petitioner of raising "purely hypothetical" questions, based on misrepresentation by petitioner of the facts contrary to the findings of the lower courts. Respondents, however, can point to no instance of such alleged misrepresentation. On the contrary, petitioner stated the facts in its petition and brief exactly as found by the courts below. The only questions presented are questions of law arising upon the facts as found.

Respondents say (Brief, p. 2) that "there is no question of public importance here raised *which has not heretofore been decided* by this Court" (emphasis in text). Respondents, however, cite no decision of this Court (or indeed of any other court) which is dispositive of any of the important questions raised by petitioner. The decisions of this Court cited by the Court of Appeals and referred to at page 7 of respondents' brief are not controlling, for reasons fully pointed out at page 18 of petitioner's main brief.

Respondents' contention (Brief, p. 3) that the requirements of R.S. Sec. 4888, relied on by petitioner as invalidating the claims, apply only to the machine patent and not to the method patent is without merit. The requirement of the statute that "in case of a machine he shall explain the principle thereof" makes no distinction between a patent which claims the method of operation of a machine and one which claims the machine as such, the courts below did not recognize such alleged distinction, and respondents cite no authority which does.

Respondents' brief asserts, without support, that the patents in suit are for "pioneer inventions," and devotes much space to a discussion of the alleged importance of the machine, matters which, if true, would have no bearing whatever on the issues raised by the petition. Actually, the alleged invention was a mere "combination of two old and well known devices," as the District Court specifically held in its opinion at R.I. 14, the passage quoted at page 15 of respondents' brief.

Respondents do not deny (as they could not) that the shoe machinery industry here affected is concentrated in the First Circuit. The fact that petitioner has been a party to patent litigation on shoe machine patents in other Circuits (see Respondents' Brief, p. 10 and Appendix B) in

no way indicates that there is any likelihood of further litigation on the patents here involved in any other Circuit.

It is submitted that respondents' brief shows no ground for denial of the petition, and that the petition should be granted in order that the important questions therein raised may be authoritatively settled by this Court.

Respectfully submitted,

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INTERNATIONAL SHOE MACHINE CORPORATION,
Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

Respondents are here confronted with a petition in which fact is inextricably mingled with argument and with repeated reference to petitioner's contentions advanced below but which were rejected by the trial and the appellate courts.

The petition and brief in support thereof do not show that this case comes within the provisions of Section 5 (b) of Rule 38 of this Court.

The Patents in Suit have Never Previously been Litigated.

This case does not present a question upon which varying views have been expressed by different Circuit Courts of Appeals; nor a situation in which a Circuit Court of Appeals has decided an important question of Federal law which has not been but should be settled by this Court; nor has the Circuit Court of Appeals decided a Federal question in a way probably in conflict with applicable decisions of this Court; nor is this a case in which further litigation in other Circuits would be at all unlikely.

There is no question of unusual public importance here raised *which has not heretofore been decided** by this Court. Instead this is an ordinary patent case involving the usual questions of infringement and validity, and concerns only the parties involved.

History of the Case.

The subject matter of the controversy involves the lasting of shoes. Petitioner is the United Shoe Machinery Corporation, which for almost fifty years has been supplying a general line of shoe machinery, including lasting machines, to the shoe factories. Respondents are the inventor Kamborian and his Company, the licensee under the patents here in suit. The only important products of the respondent Company are the lasting machines of the patents in issue. The invention is of *pioneer character* (R.I. p. 14, par. 3).† (For a further history of the invention see Appendix A.)

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*Emphasis ours throughout.

†We refer herein to the Transcript of the Record in the first appeal as R.I., and to the additional Transcript of the Record in the second appeal as R. II.

This case has been *unusually* well tried and reviewed. Petitioner has had adequate opportunity to persuade the lower courts to accept and approve its views of this case. At two successive trials the District Judge had opportunity to study the patents in the light of the evidence and to observe the operation of the patentee's machine embodying the invention. The Circuit Court of Appeals twice reviewed the findings of the District Court.

The two reviewing opinions below were rendered by the same Circuit Court of Appeals. The same judge wrote the successive opinions. It is true that one judge was replaced by another at the second hearing, but there was no dissent. In fact, petitioner had the benefit of consideration by *four* judges rather than the usual three. In both opinions the Circuit Court of Appeals concurred with the District Court in the finding of infringement, and in its second opinion unqualifiedly affirmed the District Court's findings that the patents are valid.

Statement.

Petitioner (almost completely disregarding the presence of two method claims in the case) now seeks a further review of the case on the ground that the claims do not meet the requirements of Rev. Stat. § 4888.

Obviously criticisms of the machine claims, as not complying with those provisions of Section 4888 of the Revised Statutes, which concern a *machine* only, do not apply to the method claims. Thus, even if petitioner's contentions were to be sustained as to the machine claims, petitioner would still infringe valid claims, as held by the courts below.

The patented machine is widely and successfully used for its intended purpose. Petitioner has accorded to the

patented machine the compliment of infringing imitation. Petitioner's attack on validity for failure to comply with Section 4888, Rev. Stat., was *originally* aimed at a supposed failure of the patent to describe an operative machine.

The burden of proving inoperativeness in a patent case is heavily on the defendant (*Remington Cash Register Co.* v. *National Cash Register Co.*, 6 F. (2d) 585), but in this instance the defendant never attempted to demonstrate inoperativeness of the machine itself, and confined itself largely to theoretical argument, leaving it to respondents to show positively, which they did (R. II, p. 109, beginning at line 8), that the patented machine does work when constructed and operated as described in the patent (R. II, p. 39, line 29 *et seq.;* p. 43, line 16; pp. 53-55).

The admitted operativeness of the Kamborian commercial machine compelled petitioner to take refuge in the fact that, in the commercial machine then in use, a certain work guide (illustrated and described in the patent) was omitted. On this basis, at the first hearing before the Circuit Court of Appeals, petitioner plausibly (but not convincingly) argued, without evidential support, that the omission ("jettisoning") of this guide accounted for the operativeness of the commercial machine, and deduced therefrom that the commercial machine operated according to a theory or principle different from that set forth in the patent.*

The utter fallacy of petitioner's argument was proved by respondents, who demonstrated in the presence of the

*Specifically, petitioner *urged* that with the work guide in place, as shown in the patent, the machine was inoperative, but that in the operative, commercial machine (in which the work guide was omitted) the stressing force necessary for lasting could be and was supplied by the operator himself.

District Judge and to his complete satisfaction (R. II, p. 19) that no such supposedly new theory or principle was involved, and that the machine does operate satisfactorily to last shoes *when equipped with the work guide* of the patent.

No serious question was raised below as to the sufficiency of the patent to tell the world *how to build* the machine. In its first opinion the Circuit Court of Appeals remarked:

> "The detailed description given in the Kamborian application is no amateur's job. The machinery is described in detail with drawings which were done with professional accuracy" (R. II, pp. 25, 26).

The instructions found in the patent for *operating* the machine are ample, when followed, to accomplish the intended result (R. II, p. 109).

That which establishes the Kamborian machine as a pioneer in the lasting machine field and which distinguishes it from all of petitioner's prior machines (R. pp. 152, 153; XQs. 553, 554) and from all that went before it in the lasting art (R. I, p. 14), is the *uninterrupted* advance of the work (such as results from the employment of a constantly rotating feed roll) by means which positively grips the work, while the lasting stress is being applied, and which simultaneously delivers the work into the field of action of a wiper device competent to wipe the material in as fast as it escapes from the gripping means.

Petitioner urges (though it did not plead it) that the patent fails to tell *"how the machine works."*

How the machine operates in accomplishing the new mode of lasting is clearly pointed out by the patentee, who says:

> "Thus the rolls not only exert upward pull but also tend to move the material of the upper in a direction substantially parallel to the edge of the insole, in other words to *exert a feeding action* upon the work tending to move the last and the upper in a direction longitudinal of the last. . . . As the *gripper* rolls *feed the work* along they stretch it and then release it and as it is released it is engaged by the *rapidly vibrating* wiper 44 and is wiped in smoothly over the bottom of the insole" (Patent No. 2,251,284 [R. I, p. 189], p. 3, col. 2, of the patent specification, beginning at line 15).

The Circuit Court of Appeals in its first opinion, observing that the "statute requires that the inventor describe *how his machine works*" (R. II, p. 27), remanded the case in order that the District Judge might "give explicit findings" (R. II, p. 29) as to whether the Kamborian machine works as described.

In its second opinion the Circuit Court of Appeals said (R. II, p. 107):

> "We sent the case back for further consideration for we were not clear whether the machine operated the way the inventor said it did. . . . We posed several questions which we thought brought the issue into focus."

The opinion then notes that to each of these questions the District Court "gave an affirmative reply" (R. II, p. 108), and continues (R. II, p. 109):

> "An examination of the record reveals evidence to support the fact conclusions reached in answer to the questions we asked upon remand.

"The question involved is purely factual and Rule 52 is applicable. Kamborian is bound to show *how his machine works* but not why. *He satisfied his burden* when he showed the procedure whereby a shoe, not lasted when the journey through the machine began, comes out lasted in a manner described as 'satisfactory' to 'very good' *in accordance with the directions in his* patent"; citing *White* v. *Bruce Co.*, 152 F. (2d) 304; *Eames* v. *Andrews*, 122 U.S. 40; and *Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U.S. 428, 435-436.

The Circuit Court of Appeals thus recognized and followed the interpretation of Rev. Stat. § 4888, as established by this Court. No contrary nor qualifying decisions of any court have been cited upon this point by petitioner. *Beidler* v. *United States*, 253 U.S. 447, 453, follows the above-cited decisions of this Court. (That a proposal has been made to *amend* this section of the statute [as stated by petitioner's counsel] is no indication that further judicial comment is required at this time.)

As noted by the Circuit Court of Appeals, the matter is purely factual. It was decided only after careful consideration in the light of answers to mandated questions directed to this particular point; the District Judge heard further testimony and answered these questions; the Circuit Court of Appeals examined the record; found the evidence to support the fact conclusions; and held that Kamborian had satisfied his burden of showing how his machine works.

It is submitted that respondents should not be compelled to relitigate this matter.

With reference to the sufficiency of the two machine *claims* here in issue, the Circuit Court of Appeals in its second opinion observed (R. II, p. 110):

> "We think these claims when read with the specifications state the *physical combination* of the various mechanical elements and *their functional interrelationship and operation* in a manner sufficient to describe the function of the wiper. Claim 28 points out that the wiper engages a portion of the leather while 'stress (by the gripping means) is being concomitantly applied' to another area of the leather. If the foregoing language is ambiguous or not definite enough, the meaning is made clear in the explanatory specifications."

Thus the Circuit Court of Appeals specifically rules that the claims 26 and 28 here in issue are sufficient, definite and non-ambiguous. In explaining the use of a pair of gripper rolls and rapidly reciprocating wiper as a means for accomplishing the desired result, Kamborian disclosed the best mode known to him at that time for applying the principle of the invention. As this Court remarked in *Smith* v. *Snow,* 294 U.S. 1, 11:

> "We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. . . . it is not necessary to embrace in the claims or describe in the specifications all possible forms in which the claimed principle may be reduced in practice."

Respondents do not conceive that the decision of this Court in *Halliburton Oil Well Cementing Co.* v. *Walker,* 329 U.S. 1, categorically disapproves patent claims in which one or more elements are recited as means for doing this or that; in particular where, as here, the invention is of

pioneer character. Nor do they conceive, indeed, that the doctrine expressed in the Halliburton decision is a novel one, as the Court itself seems to say on page 11 of the report. However, it may be observed that claims 26 and 28 here in issue are precisely in the form of the claim approved by this Court in *Morely Sewing Machine Co.* v. *Lancaster,* 129 U.S. 263, 266, 268, where, as here, a pioneer invention was involved.

Re Petitioner's Four "Questions Presented."

These questions are purely hypothetical. They do not appear to be predicated upon the facts as found and accepted by the courts below, but upon petitioner's version of the facts as it would like them to be or upon its own biased views as to what the Circuit Court of Appeals decided.

To answer these questions in the form in which they are propounded would necessitate trial *de novo.*

The Reasons Relied upon for Allowance of the Writ.

Paragraph 1, sections *a* to *d,* are substantial repetitions of the "Questions Presented," but in declaratory form.

They find no basis in the opinion below, but rest upon the bland assumption by petitioner that it is correct as to the facts and that the Circuit Court of Appeals is wrong.

The opinion of the Circuit Court of Appeals fully and clearly answers and refutes petitioner's assertions as to alleged errors in the patent in suit. No reason is advanced which finds a basis in the opinion of the Circuit Court of Appeals, as actually rendered, and no proper reason has been advanced necessitating re-examination by this Court.

Paragraph 2*a*: The Circuit Court of Appeals has not found and has not decided in this case that a claim to a combination of *two* means, coacting to perform a designated function, is infringed by a machine in which said function is performed by a single means. The machine of the patent and the accused machine were found to have *corresponding* elements (Judge Sweeney's first opinion, R. I, p. 16, last paragraph). *Westinghouse* v. *Boyden Power Brake Co.*, 170 U.S. 537, seems to have no application.

Paragraph 2*b*: No question as to the form of the claims in issue was ever raised below. The decisions cited by petitioner do not appear to be applicable here.

Paragraph 3: No evidence has been adduced to suggest that future litigation before Circuit Courts of Appeals for other Circuits is unlikely, as respects the patents here in issue, or to show that the decisions cited by petitioner are applicable to the present case. If petitioner's counsel count on judicial notice in support of this ground, respondents may be permitted to state that shoe machinery is manufactured in others than the First Circuit, and installed and used across the entire country. (See Appendix B for specific cases in other Circuits to which petitioner itself was a party and involving shoe machine patents.)

Paragraph 4: It is submitted that the two appellate decisions herein are in perfect accord; but, if they are not, the second decision dominates and there is nothing in the circumstances in the case to suggest any such conflict of decisions between *different* Circuit Courts of Appeals as to bring the case within either the letter or the spirit of Supreme Court Rule 38, 5 (b).

Re Petitioner's Brief.

Petitioner's constant reference to its own contentions below (as though said contentions were actual fact) and its apparently improvident statements as to the findings of the courts below result in such confusion that it does not appear incumbent upon respondents to attempt to answer in particular each of the allegations of the brief.

Conclusion.

Perusal of the second opinion of the Circuit Court of Appeals will suffice to show that all matters of fact and law relevant to the case presented were considered; that the law was correctly applied to the facts found; and that these facts were established chiefly, and almost wholly, by the undisputable evidence furnished by the operation of structures, respectively, shown in the patents in suit and made by respondents. It is also manifest, upon reading the petition and the brief in support thereof, that the writ of certiorari is prayed for solely for the purpose of having this Court review the evidence in an ordinary patent case on the ordinary questions of validity and infringement; that the lower courts found all the elements of the patented combination, or their equivalents, in the defendant's structure; that in deciding the patents were valid and petitioner infringed, the courts below followed established rules of law; and that the case is of importance only to the parties thereto. It is precisely the kind of case which does not warrant the issue of a writ. *Layne & Bowler Corp.* v. *Western Well Works, Inc.*, 261 U.S. 387. *Keller* v. *Adams-Campbell Co., Inc.*, 264 U.S. 314. *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U.S. 405, 416, citing *La Bourgogne*, 210 U.S. 95, 114. *Universal Oil Products Co.*

v. *Globe Oil & Refining Co.*, 322 U.S. 471, where the Court remarked (on p. 473):

> "Where the questions presented by the contested claims of infringement and validity are purely factual, this court ordinarily accepts the concurrent conclusions of the district court and Circuit Court of Appeals in these cases," citing *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.*, 321 U.S. 275 (60 U.S.P.Q. 386).

Respectfully,

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APPENDIX A.

Brief History of the Kamborian Invention.

For convenience the petitioner, the United Shoe Machinery Corporation, is here referred to as the "United," and the co-respondents Kamborian and the International Shoe Machine Corporation as "Kamborian."

For almost fifty years the petitioner, United, has been supplying the shoe industry with machinery, including lasting machines. At present it maintains a staff of over two hundred employees in its research or experimental department (R. p. 123, XQs. 297, 298; p. 152, XQ. 539). United has taken out a great many patents for lasting machines. However, throughout its entire history its only commercial machines have slavishly followed the old hand-lasting procedure (originally performed by hand with the aid of a pair of pincers) of gripping the margin of the shoe upper at a given point by means of nippers (in the machine, mechanically actuated), exerting updrafting stress at this point to stretch the upper about the last, drawing or wiping the stretched portion of the upper inwardly over the last bottom and fastening it, then opening the nippers and shifting them to another part of the upper, and so continuing intermittently, step by step, until the lasting is completed. It never had a successful lasting machine of the *continuous* type using in combination a work-feeding roll and wipers prior to the accused machine (R. p. 152, XQs. 553-555).

Kamborian was an experienced and skilled shoe-laster familiar with the usual commercial machines built by the United. He conceived the wholly novel idea that opposed, gripping and feeding rolls could be employed for gripping the material of the shoe upper while applying the updrafting stress. Being familiar with the necessities of the last-

ing operation, he would naturally expect to include an appropriate form of wiper, and requisite parts to position a shoe properly in any machine employing such work-gripping rolls. Having no facilities for technically designing or properly building such a machine, he himself put together his first crude model from scrap material. And when completed, behold, it worked! It was the *first* machine to do *continuous* lasting successfully. His machine was far simpler and less complicated than the machines previously available to the shoe manufacturer and in its commercial form greatly speeds up production and reduces costs.

After two years of struggle—plagued by financial difficulties and dilatory machine builders—he finally got his machine into commercial form. In the meantime he had filed his patent application in which he illustrates, in its essentials, his first crude but operative model. Observing that his helically ribbed rolls, when associated with the other parts of his machine, exerted the updrafting stress necessary to lasting, he so described their action in his application. (Demonstration before the District Court proved that his machine actually does exert the necessary updrafting stress.)

Kamborian's essential concept was to substitute (for the usual prior, intermittently acting, opposed nipper jaws) a novel gripping means which, while holding the upper with a firm, positive grip, will uninterruptedly feed the shoe along while the lasting stress is being applied and which, as it seizes a new era, delivers the area which has just been stressed into the field of action of a wiper device of a kind capable of wiping in the material as fast as it is delivered to it by the gripping means. His illustrative embodiment of such a continuously acting gripping device is a pair of opposed, constantly rotating rolls, and his illustrated embodiment of a wiper device was a rapidly recip-

rocating, narrow finger or blade. At the time when he made his application for patent this was the best embodiment known to him.

Kamborian was a pioneer inventor (Judge Sweeney's Opinion, R. I, p. 14, par. 3, where Judge Sweeney said: "The Kamborian machine provided a *continuous,* instead of a step by step, lasting operation. This was the first successful machine of this type on the market. . . . By a combination of two old and well-known devices, Kamborian has achieved that success for which the industry had been searching for a long time. . . . The Kamborian machine produced the first successful technique for *continuous* lasting, . . .").

Kamborian had mapped out a wholly new path in an ancient field. The broad claims of his patent here in issue refer to his opposed rolls broadly as "gripping means." Other claims of his patent specifically refer to the *opposed rolls.*

Although Kamborian was without adequate means for publicizing his new machine, the immediate demand for it in the trade was so great that for a long period he was unable to satisfy the demand.

The United Shoe Machinery Corporation, with its highly organized plant for designing and building shoe machinery and with its corps of more than two hundred men in its research department, and although free to build any one of the lasting machines disclosed in its hundreds of expired and unexpired patents, immediately took steps to appropriate the basic features of the new Kamborian machine. Kamborian put his first commercial machine on the market in February, 1941, and the United had its first machine of the continuous type in experimental operation in a shoe factory in 1943. It is true that the United did not make a Chinese copy of Kamborian's patented machine, but its machine functioned in the same way and by the use

of equivalent means as specifically found by the District Court (Opinion, R. p. 16):

> "Both machines provide for the automatic feed of the work. Both machines provide gripping means which, during the progress of the work, constantly seizes fresh portions of the material of shoe upper, while, at the same time, releasing the portions of just previously seized and stressed, the latter immediately being engaged by wiping means. Both machines have work engaging elements; plaintiffs', two oppositely rotating rolls, defendant's, one rotating roll acting against a polished plate. These work engaging elements exercise on both machines a positive grip, with varying amounts of slippage. In both machines the gripping means operate not only to feed the work forwardly, but also to tension the material of the upper. . . . Both machines provide for a wiper to engage the margin of the upper material immediately after it leaves the gripping means, and lay it down into adhesive contact with the insole."

APPENDIX B.

Cases in Other Circuits.

The following patent cases to which the *United Shoe Machinery Corporation has recently been a party* arose in other Circuits:

United Shoe Machinery Corp. v. *Ferree,* 64 F. (2d) 101; *Second* Circuit. The patent involved related to a clicking machine, used in the shoe industry.

United Shoe Machinery Corp. v. *Gordon,* 59 F. (2d) 903; *Sixth* Circuit. The patent involved concerned a machine for cutting on heel seats, used in the shoe industry.

United Shoe Machinery Corp. v. *Brooklyn Wood Heel Co.*, 77 F. (2d) 263; *Second* Circuit. The patent involved related to a machine for grooving wood heels, used in the shoe industry.

United Shoe Machinery Corp. v. *O'Donnell*, 84 F. (2d) 383; *Sixth* Circuit. The patent involved concerned a folding machine, used in the shoe industry.

United Shoe Machinery Corp. v. *Williams*, 121 F. (2d) 273; *Sixth* Circuit, which concerned two patents, one being a *lasting* machine, and the second a fastener inserting machine, both used in the shoe industry.